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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/296,534 04/22/99 HALLOWITZ

R BIOTI-7

023599 HM12/0816
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EXAMINER

ZEMAN, R

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

08/16/01

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/296,534

Applicant(s)

Hallowitz et al.

Examiner

Robert A. Zeman

Art Unit

1645



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 18, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-19 is/are pending in the application.
- 4a) Of the above, claim(s) 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15, 16, 18, and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims 1-13 and 15-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 1645

DETAILED ACTION

Continued Prosecution Application

The request filed on 6-18-2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/296,564 is acceptable and a CPA has been established. An action on the CPA follows.

The amendment filed on 6-18-2001 is acknowledged. Claims 18 and 19 have been added. Claims 1-13, 15-16 and 18-19 are pending and currently under examination. Claim 17 remains pending but withdrawn from consideration as drawn to a non-elected invention.

Priority

W The objection to the specification with regard to the priority statement is maintained for reasons of record. Application No. 09/139,663 is still improperly referred to as Application No. 09/139,633 throughout the specification.

Oath/Declaration

M The objection based on the oath or declaration being defective is maintained for reasons of record. The oath fails to identify priority documents by application number and filing date therein.

Art Unit: 1645

Claim Rejections Maintained

35 USC § 103

Claims 1-13, 15-16 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chun et al (Nature Vol. 387, pages 183-188 May 1997) in view of Chun et al. (Nature Medicine Vol. 1 Number 12, pages 1284-1290. December 1995) and Essex et al. (U.S. Patent 4,725,669) and the rejection of claim 13 under 35 U.S.C. 103(a) as being unpatentable over Chun et al (Nature Vol. 387, pages 183-188 May 1997) in view of Chun et al. (Nature Medicine Vol. 1 Number 12, pages 1284-1290. December 1995) and Essex et al. (U.S. Patent 4,725,669) and Chun et al (Journal of Experimental Medicine. Vol. 188 Number 1, July 6, 1998 pp 83-91) are maintained for reasons outlined in the rejection of claims 1-13 and 15-16 in Papers No. 5, 7 and 11.

New Claim Objections

Claims 2-13 and 15-16 are objected to as each claim should be introduced by an article. Independent claims should be introduced by "A" or "An" and dependent claims by "The".

New Claim Rejections - 35 USC § 112

Claims 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1645

Claims 18 and 19 are rendered vague and indefinite by failing to recite active method steps that read on the preamble of said claims.

Claims 18 and 19 are rendered vague and indefinite by the use of the term “cell population” It is unclear what cell types Applicant is claiming. How would the claimed method be used on cell populations that aren’t susceptible to HIV infection? As written, it is impossible to determine the metes and bounds of the claimed invention.

Claims 18 and 19 are rendered vague and indefinite by the use of the phrase “under effective conditions”. Is Applicant referring to the conditions under which the agent is contacted with the cells or the conditions in which the cells are cultured? As written, it is impossible to determine the metes and bounds of the claimed invention.

Claim 19 is incomplete because the preamble recites “A method of determining latent viral load” but there is no language that serves to correlate the result of “determining the number of cells expressing gp120” with “determining latent viral load”.


Conclusion

No claim is allowed.

Art Unit: 1645

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (703) 308-7991. The examiner can be reached between the hours of 7:30 am and 4:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, Donna Wortman, Primary Examiner can be reached at (703) 308-1032 or the examiner's supervisor, Lynette Smith, can be reached at (703)308-3909.


DONNA WORTMAN
PRIMARY EXAMINER

Robert A. Zeman

August 14, 2001